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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,204	12/05/2003	Roger Thomas	P-US-PR-1106	2444
7590	08/29/2005		EXAMINER	
Michael P. Leary Group Patent Counsel Black & Decker Corporation 701 E. Joppa Rd, Mail Stop TW199 Towson, MD 21286			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	
			DATE MAILED:	08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,204	THOMAS, ROGER	
	Examiner Shelley Self	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 4/28/04 12/5/03
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “52” has been used to designate both *expulsion aperture* (pg. 5, lines 10, 13, 33) and *internal wall* (pg. 5, line 32).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: *s126* (pg. 9, line 30).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 80.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *transparent window* (clm. 4), *bayonet type connector* (com. 10), *two pegs* (clm. 12) and *hoop* (clm. 15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/729231. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely re-worded. For example, the claims of the presently presented application are drawn to a debris collection container for a planer comprising a receptacle having a first and second rigid section and deformable section there between and a connector. The claims of the co-pending application are also drawn to a debris collection container comprising a receptacle (clm. 1) having a first and second rigid section and deformable section (clm. 1) there between and a connector. Accordingly, the claims as presented fail to set forth any distinguishing structure over that of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

The disclosure is objected to because of the following informalities:

- Page 4, line 21, "sidewaysly" is unclear
- Page 4, line 34, "rib is angled 35 in", is unclear, Examiner suggests, --rib is angled 35

degrees in--

- Claim 11, line 2, following the word, connection, "mean" should be -means--

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claims 1 and 18, neither the specification nor the drawings provide support for "...wherein the part spherical shaped dome section includes a deflector for curving the path of air and debris through substantially ninety degrees as the path passed through the part spherical dome section. The specification instead defines, "the shape of the dome is such that it acts as a deflector, bending the air and entrained debris through ninety degrees so that the air and entrained debris are traveling perpendicular to the direction they were traveling..." (pg. 7, lines 3-6). Thus the

specification does not support the dome section includes a deflector (clm. 1, lines 10-12; clm. 18, lines 14-16), but that the dome section is a deflector. Clarification is required.

Additionally with regard to claims 13-17, neither the specification nor the drawings provide sufficient antecedent basis for the terms: first rigid, second rigid and deformable section. With reference to the embodiments of figures 6-8 and 9-12, an end piece (82), bag (86, 116), frame (114, annular ring (72) and spring are defined and depicted. However, no element is clearly defined as the first or second rigid section of deformable section. Failure to clearly correlate or provide sufficient antecedent basis for the use of all terms, i.e., “first rigid section”, “second rigid section” and “deformable section” renders a clear understanding of the claimed invention difficult.

Furthermore, the following terms have not been adequately defined within the specification or the drawings to provide sufficient antecedent basis for the terms within the claims:

- connection means (clm. 11)
- transparent window (clm. 4)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 10, it is not clear what is meant by “*bayonet type connecter*”. Clarification is required.

Regarding claim 11, the word "means" is preceded by the word(s) "connection" and "biasing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Examiner suggests,, --means for connecting—and –means for biasing--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

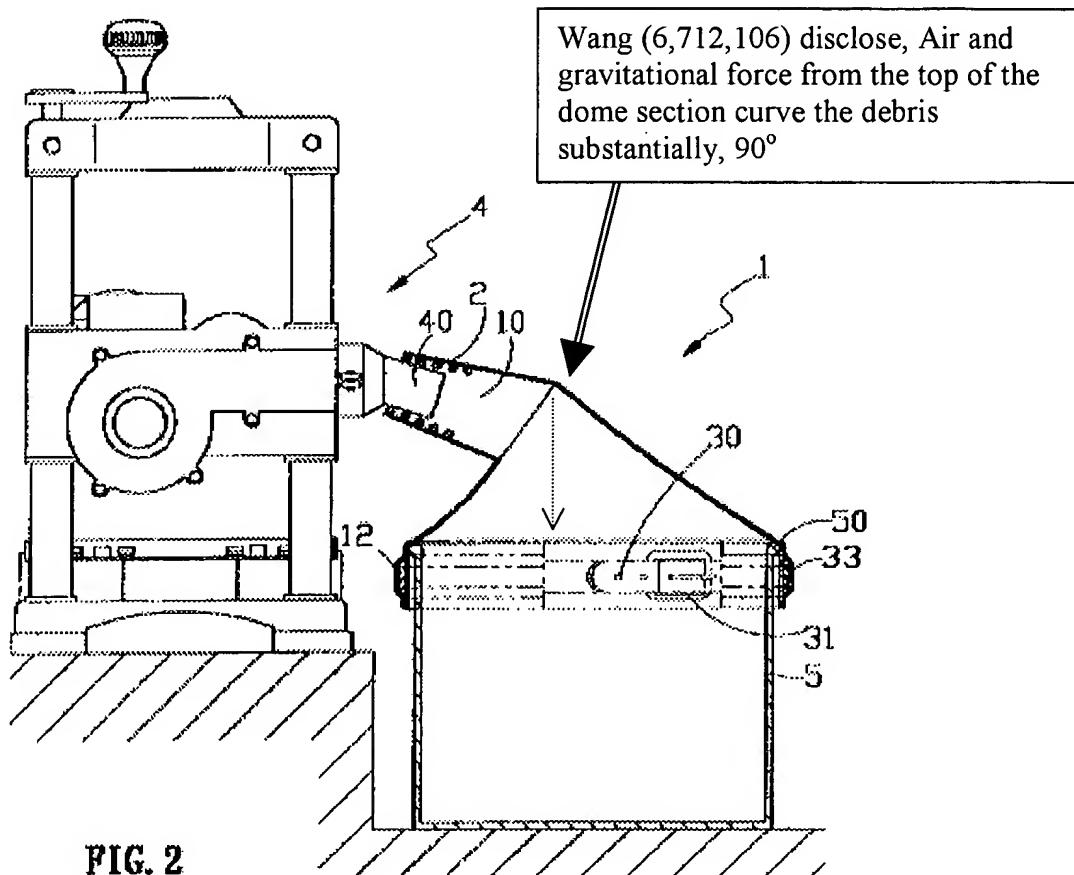
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-10 and 12 as best as can be understood are rejected under 35 U.S.C. 102(e) as being anticipated by Wang (6,712,106). Wang discloses a debris collection container (5) for a planer (fig. 2) which employs a stream of air to remove debris generated by the planer, the debris collection container comprising: a receptacle (5) for storage of the debris; and a connector (fig. 4) attachable between the receptacle (5) and the planer, the connector including a connection section and a part spherical shaped dome section (fig. 4), the connection section attached to a side wall of the part spherical shaped dome section (fig. 4) and defining an aperture through which air and debris pass from the connection section into the part spherical shaped dome section (fig. 2), the part spherical shaped dome section having a base and the base defining a

aperture through which air and debris enter the receptacle (5) and wherein the part spherical shaped dome section includes/acts a deflector for curving the path of air and debris through substantially ninety degrees as the path passes through the part spherical dome section.

Examiner notes, that the debris follows the spherical section (10) to a highest most point, i.e., along a furthest wall of the spherical section and fall by air and gravitational force downward, i.e. at 90 degrees (fig. 2).



With regard to claim 2, as best as can be understood, Wang discloses the connection section of the connector is substantially perpendicular to the longitudinal axis of the planer when the debris collection container is attached to the planer (fig. 2).

With regard to claim 3, as best as can be understood, Wang discloses the path of air and debris enters the receptacle substantially parallel to the longitudinal axis of the receptacle (figs. 2, ,3)

With regard to claim 6, as best as can be understood, Wang discloses the connection section and the part spherical shaped dome section form a cap (fig. 4).

With regard to claim 7, Wang discloses the receptacle (5) defines an aperture (fig. 1) through which debris can be removed from the receptacle (5), and the cap is releasably attached to the receptacle for sealing the aperture (fig. 1).

With regard to claim 8, as best as can be understood, Wang discloses a receptacle (5) includes a rim (50) surrounding the aperture and the cap is releasably attachable to the rim (col. 2, lines 10-20).

With regard to claim 9, as best as can be understood, Wang discloses the size of the aperture is fixed and relatively large (fig. 1).

With regard to claim 10, as best as can be understood, Wang discloses a connector whereby the cap is attachable to the receptacle (fig. 1).

With regard to claim 12, as best as can be understood, Wang discloses the cap (fig. 4) comprises part the part spherical shaped dome section.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5 and 13-17 as best as can be are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Schneider (6,520,365). With regard to claims 4 and 5, Wang does not disclose a transparent window or the part spherical shaped dome section is transparent. It would have been obvious at the time of the invention to construct the dome shaped section of a transparent material, because it is well within the general skill of a worker in the art to select a known material on the basis for its suitability for the intended use as a matter of design choice. See *In re Leshin*, 125 USPQ 416.

Moreover, Schneider teaches in a closely related art, a receptacle for debris collection and/or storage. Schneider teaches the receptacle to be constructed from anyone of various materials (col. 3, lines 12-27). Specifically, Schneider teaches the use of a netting (col. 3, line 15), Examiner notes, netting or netted fabric to be an open mesh fabric, i.e. see thru and thus transparent. Because, both Wang and Schneider are concerned with a similar problem, i.e. debris collection/storage it would have been obvious at the time of the invention to one having ordinary skill in the art to construct receptacle of transparent, netted flexible material as taught by Schneider for its transparency and ability to withstand damage.

With regard to claims 13-17, Wang does not disclose a deformable section, a second rigid section, a hoop or catch. Schneider teaches a receptacle (fig. 1) having a first rigid section (14), a second rigid section (16, 28) and a deformable section (12, 18) of transparent material located

between and connecting the first rigid section and the second rigid section (figs. 1, 2), the deformable section (12, 18) includes a helical spring (20) and is manipulatable between a compressed condition and an expanded condition (figs. 1, 2); wherein the first rigid section (14) defines an aperture and can be releasably attached to the second rigid section (16, 28) when the deformable section is in a compressed condition (fig. 2) and wherein the first rigid section is adjacent to the second rigid section. Schneider also teaches, a hoop/loop and catch (64, 66) included on the first and second sections (14, 16) for releasably attaching the first section (14) to the second section (16, 28).

Schneider teaches this construction of a storage/debris receptacle so as to allow efficient storage of the receptacle when not in use. Because both Wang and Schneider teach debris/storage receptacles, it would have been obvious at the time of the invention to replace Wang's receptacle (5) with a collapsible receptacle (i.e. first and second rigid sections) so as to facilitate compact and efficient storage of the receptacle when not in use as taught by Schneider.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao et al (6,481,478). As noted above with reference to claim 1, Wang discloses a planer, a planer body, a conduit and a debris collection container. Wang does not disclose a cutting drum rotatably mounted in the planer body, however it is obvious that Wang

has a means for cutting so as to planarize a workpiece. Accordingly, Liao teaches in a very similar art, a planer (fig. 2) having a planer body, debris exhaust conduit (43) and rotatably cutting member (35) mounted within the planer body.

Because both Wang and Liao are from a similar art and deal with a similar problem (i.e., collecting/storing debris from a planer apparatus/device) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Wang's means for cutting with a rotatably cutting member as taught by Liao so as to efficiently planarize a work surface.

Allowable Subject Matter

Claim 11 appears to contain allowable subject matter and is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the 35 U.S.C. 112 rejection(s) were overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest a debris collection container for a planer comprising a means for connecting comprising a first part including two pegs and a second part having a T-shaped slot, wherein one of the first part and the second part is mounted on the receptacle and the other of the first part and the second part is mounted on the cap in combination with the rest of the claimed limitations as set forth in claim 12.

The prior art reference, Wang discloses a connector (80) having rails, connection plates (81) and grooves (801) such that the plates (81) are positionable within the grooves (801) of the rails (80) so as to connect the cap (fig. 4) to the receptacle (5). Further, Wang discloses that the

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cap (fig. 4) is connected to the receptacle by the fastening member (31, 33, 300). Wang does not disclose or fairly suggest first and second parts having pegs and T-shaped slots wherein a one of the first and second parts is mounted on the receptacle and the other of the first and second parts is mounted on the cap. Instead, Wang discloses that the means for connecting the cap to the receptacle is mounted on the cap (fig. 4) with a flange (50) on the receptacle to correlate with the rails (80) and fastening means (33). Accordingly, Wang fails to anticipate or render obvious the claimed invention as set forth in claim 11.

Neither the prior art of record alone or in combination thereof discloses the claimed invention as set forth in claim 11. Therefore, claim 11 contains allowable subject matter over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
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